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MAILED

APR 30 2010

OFFICE OF PETITIONS

In re Patent No. 7,572,126 : DECISION ON REQUEST
Bihua Liu : FOR
Issue Date: August 11, 2009 : RECONSIDERATION OF
Application No. 10/634,526 : PATENT TERM ADJUSTMENT
Filed: August 5, 2003 : and
Atty Docket No. : NOTICE OF INTENT TO ISSUE
1365-US : CERTIFICATE OF CORRECTION

This is a decision on the petition filed on August 21, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted, by one thousand four hundred thirty-eight (1438) days. For the reasons stated below, the petition is treated as a petition requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted, by one thousand two hundred twenty-nine (1229) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred twenty-nine (1229) days is **GRANTED to the extent indicated herein.**

As to the "B" delay, the period is the period beginning on August 6, 2006, the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) and ending on August 11, 2009, the date the application issued as a patent, or 1102 days. See, 35 U.S.C.

154(b)(1)(C)(iii). The 333 days between February 17, 2008, the day after the date four months after the date a response to an Office action was filed, and January 14, 2009, the date the notice of allowance was mailed, and the 45 days between June 28, 2009, the day after the date four months after the date the issue fee was paid, and August 11, 2009, the date the application issued as a patent, overlap with the 1102 days.

Thus, the non-overlapping period is 724 (1102 - 333 - 45) days. It is further noted that a period of 589 days of over three years delay was entered at issuance of the patent. Therefore, the total "B" adjustment now due is 135 (724 - 589) days.

Patentee further asserts that a 1311 day period of adjustment for Office delay should be entered pursuant to 37 CFR 1.702(a)(4) for failure of the Office to issue the patent within four (4) months of applicant's payment of the issue fee on September 8, 2005.

Patentee's argument is not persuasive. As noted in the *Federal Register*, Section 1.703(a)(6) pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(iv). Section 1.703(a)(6) specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent was issued. The date the issue fee was paid and all outstanding requirements were satisfied is the later of the date the issue fee was paid or the date all outstanding requirements were satisfied. **If prosecution in an application is reopened after allowance (see MPEP 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP 1308).**¹

On September 8, 2005, the issue fee was paid. On June 20, 2007, however, a Notice of Withdrawal from Issue 37 CFR 1.313 was mailed, indicating that the application is withdrawn from issue to permit reopening of prosecution. On July 16, 2007, an Office action was mailed stating that the allowability of claims 16-25 is withdrawn in view of newly discovered references. As such, the showing of record is that prior to issuance of the patent, the claims were found not to be allowable. Accordingly, the

¹ See 65 Fed. Reg. 56366, at 56369 (Sep. 18, 2000).

showing of record is that not all outstanding requirements were satisfied pursuant to 37 CFR 1.703(a)(6). Therefore, no adjustment is due in connection with the payment of the issue fee on September 8, 2005.

Pursuant to 35 U.S.C. 154(b)(1)(A)(iv), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the failure of the Office to issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied. The Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Patentee further asserts that the 120 day period of reduction for the filing of a miscellaneous incoming paper on January 30, 2009, should be removed. Upon review, the paper filed on January 30, 2009, was the initial petition for review of the PTA. As a petition for review of PTA is not considered a failure to engage in reasonable efforts to conclude processing or examination, the 120 day period of reduction is not warranted and will be removed.

The patent term adjustment will be corrected to 1229 (513 (135 + 333 + 45) days of Office delay + 724 (1102 - 378 overlap) days of over three years delay - 8 days of applicant delay) days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136. See 37 CFR 1.323(a)(4).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand two hundred twenty-nine (**1229**) days.

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Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3231.

A handwritten signature in cursive script, appearing to read "D Wood".

Douglas I. Wood

Senior Petitions Attorney

Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,572,126 B2

DATED : August 11, 2009

DRAFT

INVENTOR(S) : Liu

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 974 days.

Delete the phrase "by 974 days" and insert – by 1229 days--